

REMARKS/ARGUMENTS

Claims 1-51 are active in this application. The specification has been amended to correct the spelling of "acetate" on page 11 of the application. No new matter is added. In light of the following, Applicant requests favorable reconsideration of the rejections.

THE REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

The essential inquiry pertaining to the requirement under 35 U.S.C. § 112, second paragraph is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. See MPEP § 2173.02

The methods claimed are directed to making a cosmetic article. On page 18, starting on line 8, the specification describes that the articles can be composed of various types of substrates. Examples of those substrates are listed and include, for example, polyamide, polyester, cellulose, rayon, foam, sponge-like materials, natural cloths, and non-woven substrates. Therefore, the meaning of substrate in the context of making a cosmetic article according to the claimed invention is clear. It is respectfully submitted that one skilled in the art would understand the term "substrate," particularly one having the present specification before him or her. Withdrawal of this ground of rejection is requested.

THE REJECTIONS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Cosmetic film

The Office has taken the position that the claims are not enabled because a description for making a cosmetic film is allegedly absent. Applicant disagrees.

Applicant directs the Examiner's attention to the specification on page 11, lines 3-5 which states:

The films can be formed by providing a solution of the adhesive and/or the cosmetic composition, which is then dried, for example, as the films are fed upon a large roll or upon a conveyor. Alternately, the adhesive and/or cosmetic composition can be provided as a melt mixture which is then solidified into a film upon passing over a roller or other conveyor expedient to allow the adhesive and/or cosmetic composition to cool. The adhesive can include a variety of materials including, by way of example only, ethylene vinyl acetate or polyvinyl acetate. The cosmetic composition film will include the desired cosmetic composition as well as a binder material so that the cosmetic composition can be provided in the form of a solution or as a heated mixture which solidifies upon drying and/or cooling upon a roll or conveyor to form the film. Suitable binders can include various polymers or other binder materials. Such binder materials could assist in bonding the substrate layers 10', 16' together in addition to the bonding provided by the adhesive film. Where the adhesive and cosmetic composition are provided as a single film, the adhesive can at least partially act as a binder for the cosmetic composition, and additional binders can be utilized if needed. It is to be understood that various types of binders and adhesives can be used as long as the cosmetic composition does not become fully isolated by the binder or adhesive such that the cosmetic composition can be wetted for use of the article. Preferably, the cosmetic composition is at least partially water soluble so that the articles can be used when wetted by water. However, cosmetic compositions could also be used which are oil soluble or which are best dissolved with an alcohol solution. The binder material could also be provided as a soluble or partially soluble material to further enhance the ability to wet the cosmetic composition for use. If apertures are desired in the adhesive and/or cosmetic composition film, they can be provided in any of various ways, e.g., utilizing apertures or projections on the surface of the support on which the film is formed, by blowing air through the film during forming of the film, or by piercing the film after it is formed.

Further, Applicant directs the Examiner's attention to Figure 2 and the accompanying description of the process as embodied in that Figure on page 8 through page 10, for the sake of brevity only a portion of this disclosure is reproduced below:

The process represented in Figure 2 utilizes one or more films as an alternative to depositing of the adhesive and/or the cosmetic composition onto the substrate 10' in powder form. Various forms of this embodiment are possible. In particular, either the adhesive or the cosmetic composition can be provided in the form of a film 24 which is unwound from a roll 26 and superposed upon the substrate layer 10'. If the film 24 includes the adhesive, the cosmetic composition can then be deposited on top of the film 24 via hopper or other dispensing device represented at 12'. If the film 24 includes the cosmetic composition, the adhesive can then be deposited upon the film via the dispensing device 12' . . .

In view of the extensive disclosure provided in the specification, Applicant requests that the rejection of Claims 1-51 under 35 U.S.C. § 112, first paragraph as it pertains to films be withdrawn.

Foaming surfactant

Applicant directs the Examiner's attention to the discussion in MPEP 2164.01(a) citing the Federal Circuit decisions of *In re Buchner*¹ and *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*,² which states: "A patent need not teach, and **preferably omits**, what is well known in the art." (Emphasis added).

Surfactants, in general, and foaming surfactants, specifically, are well-known in the art of cosmetics, i.e., foaming surfactants are a class of surfactants that generate foam, for example, by the application of water and agitation. Illustrative of this knowledge, Applicant attaches hereto pages 913-930 of the International Cosmetic Ingredient Handbook (3rd

¹ 18 USPQ2d 1331, 1332 (Fed. Cir. 1991).

² 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987).

Edition, Wenninger and McEwen (Eds.) The Cosmetic, Toiletry and Fragrance Association, Washington, D.C. (1995), which describes Surfactants, generally, and lists specific types of surfactants that foam.

With respect to the Examiner's comments regarding the specification at page 14, that there is no disclosure of foaming surfactants and fillers on page 14-15, the Examiner's attention is directed to pages 17-18, which includes is a description of surfactants. As to the form of the surfactant, one skilled in the art will appreciate that the surfactant may be a liquid or solid and its form will depend on whether an anhydrous powder or aqueous composition is to be applied to the substrate layers.

Applicant requests that the rejection of Claims 1-51 under 35 U.S.C. § 112, first paragraph as it pertains to lathering or foaming surfactants be withdrawn.

THE REJECTION UNDER 35 U.S.C. § 101

Applicants respectfully direct the Examiner's attention to MPEP § 2107:

. . . An invention has a well-established utility if (i) a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention (e.g., properties or applications of a product or process), and (ii) the utility is specific, substantial, and credible . . .

. . . If the applicant has asserted that the claimed invention is useful for any particular practical purpose (i.e., it has a "specific and substantial utility") and the assertion would be considered credible by a person of ordinary skill in the art, do not impose a rejection based on lack of utility. . .

The specification clearly describes that one part or example of the utility of the present invention is to improve upon methods of preparing cosmetic articles that can be used to clean the skin (see pages 1-2). In addition, as described in the first paragraph on page 8:

The cosmetic composition can take a number of forms, including foaming compositions such as surfactants, conditioner compositions, or mixtures of surfactants and conditioners. The foregoing compositions can also include

other ingredients such as vitamins, anti-wrinkle ingredients, sun screens, anti-acne, etc. The present invention could also be used for a number of other cosmetic compositions such as make-ups (e.g., a foundation make-up) or hair care compositions.

Further, page 17 at line 11 also clearly identifies an example to which the invention can be applied - - a cleansing wipe. Additional components that may be included in the cosmetic article are discussed in lines 1-2 of page 18, which further describes the utility.

Further, Applicant directs the Examiner's attention to the numerous publications that were submitted in Applicant's Information Disclosure Statement, which also describe cosmetic articles useful for cleansing and/or conditioning the hair and/or skin.

Thus, to one of ordinary skill in the art the cosmetic articles can be used, depending on the ingredients included therein, for cleaning the skin or hair, to deposit or remove make-up or other hair and/or skin benefiting agents onto the skin and/or hair. The Office has not provided any evidence of record to conclude that one of ordinary skill in the art would have any basis for doubting these asserted utilities. Accordingly, withdrawal of the rejection of Claims 1-51 under 35 U.S.C. § 101 is requested.

For the foregoing reasons, it is respectfully submitted that each of the rejections/objections of the Office Action is overcome. Accordingly, a Notice of Allowance for claims 1-51 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, he is encouraged to contact Applicant's undersigned representative at the below listed telephone number.


Application No. 09/996,584
Reply to Office Action of December 3, 2003

Respectfully submitted,

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